

### REMARKS

Upon entry of the present Amendment, the claims in the application are amended claims 8-13.

Claims 8 and 9 have been amended to overcome the 35 USC 112, second paragraph, objection.

### **35 USC 103 REJECTIONS**

The last OA rejects previous claims 8 and 9 under 35 USC 103 as being unpatentable over Schweisfurth US Patent 5,458,561.

The last OA states that Schweisfurth discloses base member 26 and needles 28 fixed therein, each of the needles comprising a base with a rod, a sharpened portion and a head (the portion closest to base member 26), the needle bases being provided with a coat of silver (col. 4, line 67 to col. 5, line 3).

The last OA concedes that Schweisfurth fails to disclose the material of the needle bases.

However, the last OA states that it is old and well known in this art to form needles of steel, for example, since this material is strong. The last OA further states that it would have been obvious to use steel as the material for the Schweisfurth needle bases so that it too would have this advantage.

As to claim 9, the last OA states that the Schweisfurth needles, as modified above, are such that adjacent needles comprise different base and coat materials. (That is, each adjacent needle comprises different base and coat materials, i.e., steel and silver).

Applicant respectfully traverses the rejection of claims 8 and 9 based on the reasons set forth hereinbelow, especially in view of the amended claims 8 and 9.

Applicant respectfully submits that Schweisfurth does not disclose or make obvious a stationary member having needles fixed therein, or that the needles are T-shaped, as now set forth in the amended claims 8 and 9.

In contrast, Schweisfurth discloses rolling bodies having projections which are uniformly distributed in a circumferential direction.

With respect to amended claim 9, Schweisfurth fails to disclose or make obvious an applicator as described in amended claim 8 wherein the needles are arranged in the applicator in such a way that the adjacent needles differ in materials exposed to an epidermis of a user of said applicator, as set forth in amended claim 9.

The last OA further rejects previous claims 10-13 under 35 USC 103 as unpatentable over Choi U.S. Patent 5,676,684 in view of Gabrusenok Soviet Union Patent 1,264,942.

The last OA states that Choi discloses base member 15 and needles (col. 5, line 14) fixed therein, each of the needles comprising a rod, a sharpened portion and a head (the portion of the needles adjacent to base member 15).

The last OA concedes that Choi fails to disclose the needles as being partially coated with different materials.

However, the last OA further states that Gabrusenok teaches that acupuncture needles should be partially coated with different materials in order to obtain the advantage of creating electrochemical potentials (abstract).

The last OA states that it would have been obvious to partially coat the Choi needles with different materials so that it too would have this advantage.

Applicant respectfully traverses the rejection of previous claims 10-13 based on the reasons set forth hereinbelow, especially in view of the amended claims 10-13.

Applicant respectfully submits that Choi and Gabrosenok, taken singly or in combination, fail to disclose or make obvious an applicator as specified in amended claim 10 where the applicator has a stationary base member and needles fixed therein, wherein each of the needles is T-shaped, as now specified in amended claim 10 and dependent claims 11-13.

In contrast, Choi contemplates a driving member including an electrical operated rotatable member coupled to a piston for continuously moving said piston back and forth to drive said acupuncture-member via said main spring.

The genius of invention is often a combination of known elements, which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

The opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. In *re Dembiczak*, 175 F. 3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); In *re Gartside*, 203 F.3d 1305, 53 USPQ 2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

Whether a motivation to combine prior art references has been demonstrated is a question of fact. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000).

It is impermissible for the Examiner to first ascertain factually what applicant did, and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966).

The test to be applied is whether the claimed invention would have been obvious to one skilled in the art when the invention was made, not to an Examiner after learning all about the invention. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983).

Inventions must be held to be nonobvious where neither any reference, considered in its entirety, nor the prior art as a whole, suggested the combination claimed. Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 932-33 (Fed. Cir. 1984).

Nowhere does the final rejection indicate where in the prior art there might be a suggestion of combining teachings of the individual references, or how, if there was such a suggestion, such combination would equal any invention claimed by applicant.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the 35 USC 103 rejection of the previous claims, especially in view of the claims as now amended, with a view toward withdrawing such rejections.

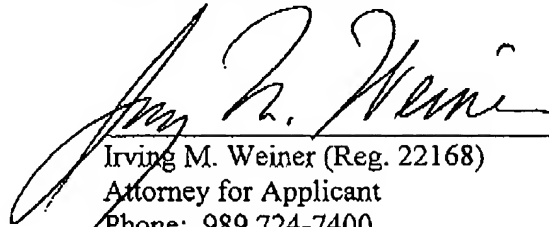
Applicant includes herewith a Petition For An Extension of Time and a form PTO-2038 to cover the extension fee.

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not convinced that the application is in condition for allowance, it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an attempt to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

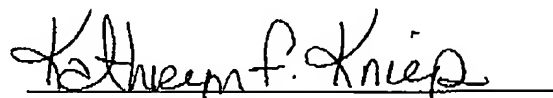
Respectfully submitted,

  
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**Certificate of Facsimile**

I hereby certify that the foregoing Amendment-B, and its mentioned enclosure, were sent by facsimile to 571-273-8300 on January 12, 2006.

  
Kathryn F. Knlep